

REMARKS

In response to the Office Action dated October 1, 2009, the Assignee respectfully requests reconsideration based on the above amendments and on the following remarks.

Claims 1-16 are pending in this application.

Rejection of Claim 16 under § 103 (a)

The Office rejected claim 16 under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent Application Publication 2002/0097727 to Prakash in view of U.S. Patent 6,483,870 to Locklear, JR., *et al.* Claim 16 has been canceled, so the rejection is moot.

Rejection of Claims 1, 6 & 8-15 under § 103 (a)

The Office rejected claims 1, 6, and 8-15 under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent Application Publication 2002/136240 to Counterman in view of U.S. Patent 6,483,870 to Locklear, JR., *et al.*

Any proposed combination of *Counterman* with *Locklear* teaches away and cannot support a *prima facie* case for obviousness. The M.P.E.P. expressly explains several situations in which a reference teaches away, including when a proposed modification “render[s] the prior art unsatisfactory for its intended purpose” or when the proposed modification “change[s] the principle of operation of a reference.” See M.P.E.P. § 2145 (X)(D). If *Counterman* is combined with *Locklear*, as the Office proposes, then *Counterman*’s principle of operation must be impermissibly changed. Indeed, significant teachings of *Counterman* must be **eliminated**. Any proposed combination of *Counterman* with *Locklear*, then, must fail. The Office is thus respectfully requested remove the rejection of these claims.

Counterman's principle of operation uses a shared line to physically separate subscribers when extra bandwidth is needed. *Counterman's* shared line, though, is not “*dedicated*” when additional bandwidth is needed. *Counterman's* shared line, in contradistinction, simultaneously delivers service to the physically separate subscribers. As *Counterman* explains, the “present invention allows the simultaneous delivery of different services to physically separate subscribers over a shared single pair of wires.” U.S. Patent Application Publication 2002/136240 to *Counterman* at paragraph [0009]. “The wire pairs are used to simultaneously carry different services to physically separated subscribers, i.e., a portion of a common line carries one service to one location and a second service to another location.” *Id.* (emphasis added). See also *id.* at paragraphs [0011] and [0025]. *Counterman's* principle of operation, then, is to provide a shared line that simultaneously delivers service to physically separate subscribers.

Locklear's principle of operation is entirely different. *Locklear* assigns pools of modems and twisted pair lines to increase data rates. Information passes between a device and a server using a modifiable number of modems. See U.S. Patent 6,483,870 to *Locklear, JR., et al.* at column 3, lines 40-44. Loading information on the modems is compared to threshold information to add or remove modems as needed. See *id.* at column 5, lines 59-65. *Locklear's* “important technical advantage ... is the establishment and maintenance of a communication session.” *Id.* at column 5, lines 53-55.

The proposed combination of *Counterman* with *Locklear* thus teaches away. *Counterman's* principle of operation uses a shared line to physically separate subscribers to simultaneously deliver service to the physically separate subscribers. *Locklear's* principle of operation, in contradistinction, increases data rates by increasing modems and twisted pair connections while establishing and maintaining a communication session. If *Counterman* is combined with *Locklear*, as the Office proposes, then *Counterman's* entire teaching of a shared line that simultaneously delivers service to physically separate subscribers must be **eliminated**. *Counterman's* entire teaching of a “shared single pair of wires” must be **eliminated**. *Counterman's* entire teaching of a “a common line [that] carries one service to one location and a

second service to another location” must be **eliminated**. The patent laws, though, forbid changing a principle of operation to make a *prima facie* case for obviousness. Any proposed combination of *Counterman* with *Locklear*, then, must fail. The Office is thus respectfully requested remove the rejection of claims 1, 6, and 8-15.

Rejection of Claims 1, 6 & 8-15 under § 103 (a)

The Office also rejected claims 2, 5, and 7 under 35 U.S.C. § 103 (a) as being obvious over *Counterman* with *Locklear* and further in view of U.S. Patent 6,452,923 to Gerszberg, *et al.*

Because the proposed combination of *Counterman* with *Locklear* teaches away, the Office is respectfully requested to remove the rejection of these claims.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 469-2629 or scott@scottzimmerman.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

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